

REMARKS

The Applicant wishes to thank the Examiner for the detailed remarks. An amendment to claim 27 has been proposed to address the improper dependency. Claims 20-23 were previously withdrawn from consideration. Accordingly, claims 1, 4, 6, 10, 11, 13-18, and 20-30 are pending in the application.

Claim 27 was objected to under 37 CFR 1.75(c) as depending from a cancelled claim. Amended claim 27 has been changed to depend from claim 10 rather than cancelled claim 12. Accordingly, Applicant respectfully requests that the amendment be entered and the objection be withdrawn.

The drawings were objected to under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims. The Examiner contends that the feature of the “said rotor rotatable while substantially submerged in said dielectric fluid to circulate said dielectric fluid through said cavity” as recited in claims 13 and 15, and the feature of “an engine” recited in claims 17, 18, and 23, and the feature of “a gas turbine engine” as recited in claim 17 are not shown in the claims. Replacement drawings are filed herewith. Figures 3 and 4 now illustrate fluid within the cavity 102, and Figure 5 illustrates an engine or gas turbine. Accordingly, Applicant respectfully requests that the replacement drawings be entered and the objection be withdrawn.

The Examiner maintained the rejection of claims 1, 4-6, 13, 14, and 20-22 under 35 U.S.C. §102(b) as being anticipated by Arutunoff. Claim 1 recites “a thermally conductive dielectric fluid.” Applicant previously argued, and maintains the argument, that Arutunoff discloses an internal liquid or oil, but does not disclose the use of a dielectric fluid. In response, the Examiner argues that the oil of Arutunoff is inherently dielectric because the stator winding would otherwise be short-circuited. Respectfully, Applicant disagrees that the oil of Arutunoff is inherently dielectric.

In order to rely on inherency as the basis for the rejection, the Examiner must show more than a mere probability or possibility that the oil of Arutunoff is dielectric. That is, the Examiner must show that the oil in Arutunoff is inevitably or invariably always dielectric. In Arutunoff, the oil passes through the passages K between the stator field coils (see page 3, column 2, lines 74-82). As seen in Figures 2 and 3 of Arutunoff, the passages K extend between the coils 18 do not appear to directly contact the coils. Therefore, the Examiner’s argument that the oil must be dielectric because the coils would otherwise be short-circuited has no basis

because the oil does not even directly contact the coils to provide the possibility of short-circuiting. For this reason, the Examiner's reliance on the oil of Arutunoff being inherently dielectric has no basis, and Applicant respectfully requests that the rejection be withdrawn.

The Examiner maintained the rejection of claims 10-12 and 16 under 35 U.S.C. §103(a) as being unpatentable over Arutunoff in view of McCabria. The Examiner argues that it would be obvious to modify the housing configuration of Arutunoff to accommodate the combination structure of McCabria "in order to improve the cooling system." Respectfully, the motivation stated in the rejection does not amount to proper motivation under 103. For one thing, the Examiner is guessing or speculating that modifying Arutunoff with McCabria would result in an "improved cooling system" without providing any evidence or explanation of what the improvement is or how one would achieve it. For this reason alone, the rejection should be withdrawn.


Additionally, the stated motivation merely recognizes a need to improve cooling and does not provide any suggestion for the particular arrangement recited in Applicant's claims. Recognition of a need is not a motivation for a particular solution (See *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 381 F.3d 1371, 72 U.S.P.Q.2d 1333 (Fed. Cir. 2004)). Thus, the burden remains with the Examiner to provide proper motivation. Accordingly, claims 10-12, 16, and 24-30 are allowable, and Applicant respectfully request that the rejection be withdrawn.

Regarding claims 11, 12, 16, and 24-27, the rejections fail to state any motivation and therefore fails to establish *prima facie* obviousness. For this reason alone, the rejection of claims 11, 12, 16, and 24-27 should be withdrawn.

Applicant believes that no additional fees are necessary, however, the Commissioner is authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds for any additional fees or credit the account for any overpayment.

Respectfully submitted,

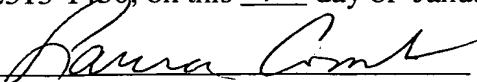
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CERTIFICATE OF MAIL

I hereby certify that the enclosed Response is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 11 day of January, 2007.



Laura Combs